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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,997	04/20/2004	David W. Caldwell	37041-11481	6796

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JENNER & BLOCK, LLP
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CHICAGO, IL 60611

EXAMINER

ARBES, CARL J

ART UNIT	PAPER NUMBER
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3729

MAIL DATE	DELIVERY MODE
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02/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/828,997

Applicant(s)

CALDWELL ET AL.

Examiner

C. J. Arbes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 26-34 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 26-34 and 36-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Claims 1-19, 26-34 and 36-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the Specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants now urge that there has to be a same etchant agent that is used to etch Applicants' 1st and 2nd conductive layers. They indicate this is one distinguishing aspect of their Application *vis-a-vis* the formerly applied Prior Art. This being said it appears and now is held that choice of etching agents is critical to this claimed invention. Given this view and reading Applicants' terse approximately 12 page Specification it appears that little or nothing is disclosed with respect to the appropriate etchant/s that can be used to achieve the claimed invention. That is not one example of any etchant agent is provided that one can use to do what Applicants wish it to accomplish. Not ant publications, references to the literature, affidavits or the like is offered or recited to allow a PHOSITA to make and use the claimed invention. There is little or no guidance to allow a PHOSITA to perform the claimed invention. The claims merely recite that this is what is done. Therefore it is held that there is lack of enablement for Applicants' invention based on the Office's above provided reasoning.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 15, 16, 32-35, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barraclough, Pat. No. 3,864,180; hereinafter Barraclough..

Barraclough teaches a process for forming thin-film circuit device wherein a substrate is covered with a thin-film layer of material having electrical characteristics corresponding to the circuit device, which is covered by an intermediate (or first) conductive material which in turn is covered by a second conductive material. (Cf. Abstract) The second conductive layer is etched to form a cavity above the intermediate layer. Subsequently the intermediate conductive and the thin-film layers are selectively etched. The etchants used for the different conductive layers are different (Cf. Col 3). It would have been obvious to selectively etch a portion of the second conductive material and selectively etch a portion of the first conductive material if in fact Barraclough does not expressly teach these limitations since the device produced has a cavity therein and does have 2 conductive layers that are placed thereon and then are removed.

Claims 1-6, 13, 14, 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barraclough in view of Japan Pat No. 03-221922, by Yuichi et al (of record) or vice versa. The Barraclough teaching has been provided hereinabove and is not repeated. The Yuichi et al teaching has been provided in a previous Office action and also is not repeated. It would have been obvious to combine the two teachings and to construct a display device by providing by, for example, sputtering a driving circuit (i.e. first conductive material) and a transparent film (comprising an InSnO(sub 2). (N.B. The thin film devices taught by Barraclough will generally be flexible.) As applied to claims 5 and 6 it would have been obvious that if one were soldering an electrical

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component to the circuit that the component would be electrically connected to the second (top-most) conductive material inasmuch as this would be expedient and practical. As applied to claims 13 and 14 it is held to be old and hence obvious to deposit at least one of the conductive materials be a vacuum means. In fact Yuichi et al do teach sputtering or electron beam evaporation of a noble metal onto a transparent substrate. (N.B. The sputtering process uses a vacuum.) As applied to claims 29-31 if indeed Barraclough does not expressly teach the specific limitations in these dependent claims. Nevertheless, it would have been obvious to e.g. etch the second conductive layer at a rate which is slower than that of a first rate (in order to properly provide the electrical circuit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. J. Arbes whose telephone number is 571-272-4563. The examiner can normally be reached on M, T, R and F from 8 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Vo, can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



C. J. Arbes
Primary Examiner
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